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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/696,097

10/28/2003

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EXAMINER

OBEID, FAHD A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/696,097	Applicant(s) KAHLON ET AL.	
	Examiner FAHD A. OBEID	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/28/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. **Claims 1-22** are pending in this application.
2. Claims 23-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/19/2008.

Applicant's election without traverse of Group I claims 1-22 in the reply filed on 08/19/2008 is acknowledged.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/696,156.

This is a provisional obviousness-type double patenting rejection.

Instant Claim

1-22

Claims in Application # 10/696,156

1-24

Regarding Claims 1-22: claims 1-22 differs from claims 1-24 in the 10/696,156 application as follows:

- Inventory balance information.

The 10/696,156 application lacks extracting inventory balance information.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include extracting inventory balance information in the 10/696,156 application for the advantage of facilitating communications between distributors, suppliers, and manufactures to provide faster services and accurate data.

3. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/696,371.

This is a provisional obviousness-type double patenting rejection.

Instant Claim

1-22

Claims in Application # 10/696,371

1-33

Regarding Claims 1-22: claims 1-22 differs from claims 1-33 in the 10/696,371 application as follows:

- Inventory balance information.

The 10/696,371 application lacks extracting inventory balance information.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include extracting inventory balance information in the 10/696,371 application for the

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advantage of facilitating communications between distributors, suppliers, and manufactures to provide faster services and accurate data.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-11 and 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 16 recite the limitation “other elements” is vague and indefinite. It is unclear what “other elements” the applicant is referring to. The phrase "other" renders the claim vague and indefinite. Thus the limitation is not positively recited.

Claim Rejections - 35 USC § 101

1. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a specific machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond

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v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

Thus, to qualify as a § 101 statutory process, the claim should: a) positively recite the specific machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or b) positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claims 1-11 fail both prongs of this test and are therefore nonstatutory.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Katz (US 2002/0178077).**

8. Regarding Claims 1 and 12: Katz discloses a method in a computing system for managing inventory, the method comprising:

- Extracting inventory balance information in a first form that is associated with a first source computerized inventory management system (internal data are extracted in a

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variety of formats and therefore require transformation “conversion”; internal data such as suppliers databases which includes information about product catalog data, product specifications, part numbers, prices, quantity, total net landed cost, delivery dates, lead time, PO histories, client inventories, distributor data, transportation schedules, supply inventories, inventory targets, vendor managed inventory etc. see at least para 42).

- Converting the inventory balance information in the first form into inventory balance information that is in a second intermediate form (transformation is the process of mapping data from source objects onto target objects and applying conversions to the data, after the transformation have been defined, then scripts are generated which perform the function of converting and loading data into target objects; see at least para 190).
- Converting the inventory balance information in the second intermediate form into inventory balance information in a target form that corresponds to a target computerized inventory management system (extraction, transformation, loading, and normalization/integration of internal data and external data; software tools are used to extract data from a source data set, transform "convert" the data through a set of business and data rules, and load the data to a target data set; see at least para 54).

9. Regarding Claims 2 and 13: Katz discloses a method of claim 1, further comprising:

- Using the inventory balance information in the target form to update an existing inventory balance record in the target computerized inventory management system (paras 39 and 201).

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10. Regarding Claims 3 and 14: Katz discloses a method of claim 1, further comprising:

- Extracting inventory balance information in a third form that is associated with a second source computerized inventory management system that is distinct from the first source computerized inventory management system (information is selected from one or more data source, consisting of suppliers, vendors, product databases etc. see para 42 and claims 22-23).
- Converting the inventory balance information in the third form into inventory balance information that is in the second intermediate form (para 190).
- Converting the inventory balance information in the second intermediate form into inventory balance information in the target form (para 54).
- Using the inventory balance information in the target form to update an existing inventory balance record in the target computerized inventory management system (paras 39 and 201)

11. Regarding Claims 4 and 15: Katz discloses a method of claim 1, wherein the second intermediate form includes a list of inventory balances class with a hierarchy of data elements (paras 122 and 208).

12. Regarding Claims 5 and 16: Katz discloses a method of claim 4, wherein the hierarchy of data elements includes a plurality of inventory balance elements that include other elements (paras 46-47, and claims 14-18).

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13. Regarding Claims 6 and 17: Katz discloses a method of claim 5, wherein each of the plurality of inventory balance elements includes a related inventory location element for defining related inventory location identifier (paras 46 and 47).

14. Regarding Claims 7 and 18: Katz discloses a method of claim 5, wherein each of the plurality of inventory balance elements includes a list of inventory balance data element for defining a plurality of inventory balance data elements (paras 46-47 and claims 14-18).

15. Regarding Claims 8 and 19: Katz discloses a method of claim 5, wherein each of the plurality of inventory balance elements includes an inventory balance custom data (paras 46-47 and claims 14-18).

16. Regarding Claims 9 and 20: Katz discloses a method of claim 7, wherein each of the plurality of inventory balance elements includes a related product element for defining a product identifier (paras 46-47 and claims 14-18).

17. Regarding Claims 10 and 21: Katz discloses a method of claim 7, wherein each of the plurality of inventory balance data elements includes a list of balance data element for defining a plurality of balance data elements (paras 46-47 and claims 14-18).

18. Regarding Claims 11 and 22: Katz discloses a method of claim 10, wherein each of the plurality of balance data elements includes: a bucket code element; a quantity of product

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element; a product unit of measure code element; and a balance data custom data element (paras 46-47 and claims 14-18).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
10/28/2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627